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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/899,378 | 07/02/2001 | Scott Patrick Alcott | 8285-422 | 9034 |

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| EXAMINER |
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FOSTER, ROLAND G

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| ART UNIT | PAPER NUMBER |
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2645

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/899,378

Applicant(s)

ALCOTT, SCOTT PATRICK

Examiner

Roland G. Foster

Art Unit

2645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 26 and 33.

Claim(s) rejected: 1-25, 27-32 and 34-37.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

RGF 11/24/04
Roland G. Foster
Primary Examiner
Art Unit: 2645

CONTINUATION OF 5: The amendment does NOT place the application in condition for allowance because:

Applicant's argues that one of ordinary skill would not have been motivated to combine Malik (U.S. Patent No. 6,181,787 B1) and Furman (U.S. Patent No. 5,465,295) in the manner suggested by the examiner. Specifically, Furman discloses "advantages using the alphabetical code to route calls" and therefore "a person of ordinary skill would not have been motivated to use the code for a different purpose, such as establishing a service of Malik."

Applicant's arguments were not considered persuasive.

Malik discloses establishing a subscription to a telecommunication service by dialing service codes from a telephone's alphanumeric keypad. Furman was relied upon for the unremarkable teaching that a service code can also correspond to an abbreviation of the service as spelled out on the telephone's alphanumeric keypad. The suggestion/motivation to combine would have been to increase the user-friendliness and accuracy involved in activating a telephone network service by relying on the mnemonic aid of dialing an alphabetic abbreviation of the service on a alphanumeric telephone keypad or rotary dialer, as is notoriously well known in the art.

Applicant directs most of his arguments to Furman individually, highlighting narrow teachings in Furman that the examiner did not rely upon to add to Malik. For example, applicant argues that Furman: 1) fails to disclose establishing a subscription to a service, 2) controls the routing of a telephone call rather than setting up a new service, 3) uses abbreviations to avoid memorizing multiple, "long" telephone numbers for the same party rather than using "short" activation codes for establishing a subscription. The examiner added none of these narrow features from Furman to Malik. For example, in no way does the examiner's proposed combination require the "same code for use and establishing a subscription" as argued by the applicant. The examiner relied upon Furman to teach "activating" a telecommunication service by using a service code that is an alphabetical abbreviation for the name of the service to be activated. "Activating" a service would include establishing a subscription to the service (e.g., ordering) (as in Malik) or initiating use of the service (as in Furman). Indeed, the applicant admits that both establishing a subscription to the service (e.g. ordering) and initiating use of the service using service codes results in a "similar disadvantage" (page 2, lines 7-16).

Despite the narrow features of Furman repeatedly highlighted by the applicant above, Malik and Furman are analogous art. Both Malik and Furman are both directed to the same field of endeavor: activating subscription telecommunications services by dialing service codes from a telephone keypad. Further, both Malik and Furman are reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Here, the problem concerned activating a service, which includes both initiating a subscription to a service (e.g., ordering) or initiating the use of a service and which the applicant admits result in "similar disadvantage" (page 2, lines 7-16). Consistent with the applicant's specification, the underlying differences in how the services are activated are not material. For example, the user would have still benefited from the mnemonic aid of a service code corresponding to an abbreviation of the service whether the user was establishing a subscription (e.g., accessing and provisioning the service for the first time) or not (e.g., simply initiating the use of a service in which the subscription was already established). Further, both Malik and Furman control the routing of telephone calls (e.g., both control call routing in order to implement voice mail services). Finally, remembering distinct service codes for a plurality of different services would have been difficult whether the codes corresponded to long telephone numbers or short codes. Indeed, applicant states that readily knowing either a "telephone number" or a "code" would result in a "similar disadvantage" (page 2, lines 7-16).

Applicant also argues that Malik fails to disclose initially establishing a subscription because Malik discloses that the service is "in contrast" to a subscription.

Applicant's arguments were not considered persuasive. When considering the full quote, Malik discloses "[i]n contrast, a telecommunication service to which a customer subscribes in a conventional manner (rather than "rents") is typically subscribed to on an open ended basis so long as the customer pays for the service." Thus, Malik is merely distinguishing conventional subscription from les conventional subscription but in both cases subscription nonetheless.

CONTINUATION OF 7: Explanation of how the amended claims will be rejected.

The applicant's amendment addresses typographical errors that do not affect the substance of the examiner's rejection. Therefore, the claim stand rejected as indicated in the prior Office action.